

REMARKS

Claims 1-33 are pending in this application. Claims 1-4, 6-10, 12, 14-16, 18, 20-24, and 26-33 stand rejected. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Applicant wishes to thank the Examiner for the indication of allowability of claims 5, 11, 13, 17, 19, and 25. Applicant respectfully defers rewriting these claims in independent form until final resolution of the above-rejected claims.

Claims 1-4, 6-10, 12, 14-16, 18, 20-24, and 26-33 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,067,082 (“Enmei”) in view of JP 02-113657 (“Suzuki”). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

Among the limitations of independent claims 1, 15, 21, 30, and 32 neither shown nor suggested by Enmei is a destination calling control apparatus having:

input means for entering destination data corresponding to the destination image area said destination data chosen from the group consisting of telephone number, fax number, and email address

As admitted in the Office Action, Enmei does not disclose a telephone number, facsimile number, or other identifying data for the destination data. Enmei discloses a portable communicator where an image (a map) is stored in ROM 69. The map has road numbers and destinations. Additionally, guide routes can be determined from the map. (Column 29, lines 32-39). Thus, no destination data is input, only stored information is read from ROM 69. No destination data corresponding to the destination image area is input in Enmei using input means as explicitly recited in Applicant's claim.

The Office Action attempts to cure this deficiency in Enmei by citing the Suzuki reference, and in particular Figure 4 where icons have separate different phone numbers associated therewith. However, this does not disclose Applicant's explicitly recited invention.

Applicant's invention relates to displaying a single image and assigning various telephone numbers, fax numbers and E-mail addresses to different areas of the single image such that the selection of any portion of the image will result in the contacting of the destination based on the destination data associated with the selected area.

Suzuki merely discloses a directory which displays both icons and telephone numbers. Suzuki fails to disclose or suggest a destination area within the image as required by all of the independent claims of the present application. In Suzuki, a number is assigned to a specific image or icon. The multiple icon screen shown in Figure 4 of Suzuki does not constitute a single image recited in Applicant's claims. Thus, Suzuki fails to teach a destination data associated destination data chosen from the group consisting of telephone

number, fax number, and E-mail where different portions of the single image are associated with separate destinations with separate phone numbers.

Further, there would be no motivation to combine the Enmei reference with the Suzuki reference.

To properly reject the Applicant's claims for obviousness in view of a combination of prior art references, the Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the cited references and, in combining them, would have arrived at the invention claimed by the Applicant. In re Kotzab, 208 F.3d 1365, 1370 (Fed. Cir. 2000). A motivation to combine may arise from: (i) either explicit or implicit statements in the prior art references themselves; (ii) the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (iii) the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

Regardless of its source, or the form that it takes, a motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also

suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

Smiths Indus. Medical Systems Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356 (Fed. Cir. 1999); see also, In re Dembiczak, 175 F.3d at 999-1000 (Fed. Cir. 1999).

The Office Action's sole justification for combining Enmei and Suzuki is precisely the sort of assertion that the Federal Circuit rejected in Smith. The Office Action argues that one of skill in the art would have applied the teachings of Suzuki to said device of Enmei "to increase the user friendliness of a mobile device." See Office Action, at 3. This assertion, however, is merely conclusory and does not say how or why a person of ordinary skill in the art would be motivated to modify Enmei in light of Suzuki.

The Office Action's assertions are general and conclusory. Simply asserting that what is taught is well-known to one of skill in the art, without more, does not provide the Applicant with a sufficiently clear and particular showing of a motivation to combine.

In summary, the Office Action fails to establish with clarity and particularity that a person of ordinary skill in the art would be motivated to change the device disclosed in Enmei, a portable communicator where an image (a map) is stored in ROM 6, with the icon directory disclosed in Suzuki. As a result, the Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1-4, 6-10, 12, 14-16, 18, 20-24, and 26-33, and that the objection to those claims under Section 103 should be withdrawn.

Claim 9 is a method claim corresponding to independent apparatus claim 1. Claim 9 explicitly requires "displaying said image data as a displayed image specifying a destination image area within said displayed image [and] entering destination data

corresponding to said destination image area said destinations data chosen from the group consisting of telephone number, fax number, and E-mail.”

As discussed above, Enmei does not teach the destination data chosen from the group consisting of telephone number, fax number and E-mail as well as failing to disclose specifying a destination image area within said displayed image.

The Office Action then attempts to cure this deficiency using Suzuki. However, Suzuki fails to cure this deficiency as discussed above.

Applicant has responded to all of the rejections and objections recited in the Office reconsideration and Notice of Allowance for all of the pending claims is therefore respectfully requested.

The amendments to the claims have been made to correct typographical errors and are not intended to limit the scope of the claims in any way. It is asserted that the present amendment places the application in a form for allowance. Entry of this amendment is therefore earnestly solicited.

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If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

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